REMARKS

This Amendment responds to the Final Office Action of March 3, 2005. Claims 1-31 have been canceled without prejudice. New claims 32-38 have been added. Favorable consideration is requested.

In the final Office Action mailed on March 3, 2005, the Examiner considered claims 1-3, 6, 7, 10-18, 21, 23, 24, and 26-31. Claims 1-3, 10-18, 21 and 27-31 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,408,282 to Buist ("Buist"), in view of U.S. Patent No. 6,021,397 to Jones *et al* ("Jones"). Claims 6, 7, 23 and 24 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Buist in view of Jones, and further in view of U.S. Patent No. 5,802,499 to Sampson *et al* ("Sampson"). In addition, claim 26 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Buist in view of Jones, and further in view of U.S. Patent No. 5,970,149 to Johnson ("Johnson").

As noted above, Applicants have cancelled all the prior claims 1-31 without prejudice. Applicants respectfully submit that new independent claims 32 and 35, together with the remaining claims respectively dependent thereon, are patentably distinct from the cited prior art for the following reasons.

Claim 32 recites:

A computer readable medium having financial advisor software stored thereon that when executed on a computing device displays an interface comprising:

an application menu;

a market data function menu; and

a display window,

wherein the application menu comprises:

a client information application selection that enables a user of the financial advisor software to search for and display client account and client transaction information in the display window in real time,

a broker entry application selection that enables the user of the financial advisor software to participate in client transactions in real time by entering or correcting client transaction orders,

wherein the market data function menu comprises:

a market data function selection that displays market data in the display window in real time,

wherein the application menu further comprises a research application selection that enables the user of the financial advisor software to research investments

and a financial planning application selection that enables the user of the financial advisor software to make recommendations regarding asset allocations and specific investment alternatives.

The cited prior art (Buist, Jones, Sampson, and Johnson) do not alone, or in combination, teach or suggest the computer readable medium recited in Claim 32. Buist, Jones, Sampson, and Johnson, alone or in combination, also do not teach, disclose, or suggest a broker entry application selection that enables the user of the financial advisor software to participate in client transactions in real time by entering or correcting client transaction orders. Buist, Jones, Sampson, and Johnson, in combination, also do not teach, disclose, or suggest the computer readable medium

recited in Claim 32 with a financial planning application selection that enables the user of the financial advisor software to make recommendations regarding asset allocations and specific investment alternatives.

Buist does describe a trading system in which a broker/dealer database checks to see if a user has sufficient shares in the user's account for a transaction and automatically sends a message to the user of the system to inform the user whether the order has been approved. (Buist, Col. 9, line 42 - Col. 10, line 25.) However, that is not the same as enabling a user of the financial advisor software to participate in client transactions by entering or correcting client transaction orders.

Jones does describe a financial advisory system with financial planning functions that include analyzing an investor's current asset allocation and suggesting an alternative allocation based on an investor's risk tolerance. (Jones, Col. 6, lines 3-34.) However, for a rejection under 35 U.S.C. § 103(a) to be proper, the references, either alone or in combination, must teach or suggest all of the claim limitations. In addition, as stated in M.P.E.P. § 2143.01, the mere fact that the references can be combined does not render the resultant combination obvious unless the prior art suggests the desirability of the combination.

Here, there is no suggestion or motivation in Buist, Jones, or any of the other cited references to combine the financial planning functions of Jones with the financial advisor software recited in Claim 32. Furthermore, as discussed above, Buist does not teach or suggest applying its security transaction system to a financial advisory system having a browser interface for use by at least one financial advisor to provide financial services to a plurality of investors having access to an online investor transaction system that provides each investor with at least one investor account to conduct therewith investor-mediated transactions.

The Office Action on page 6, asserts that, "[i]t would have been obvious to one skilled in the art at the time the invention was made to modify Buist with the financial planning functions disclosed by Jones because this would help the user/investor of Buist to model investment activities to obtain a financial goal and to have confidence that the goal could be reached with particular portfolio selections." Because the Office Action has not identified any suggestion or motivation in either Buist or Jones to combine those references, the Office Action appears to be relying on Applicants' own patent application to supply the missing motivation, which is improper.

As stated in M.P.E.P. § 2143.01, "the mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 U.S.P.Q. 1430 (Fed. Cir. 1990). As that section in the M.P.E.P. further reads, "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682. *See also In re Fritch*, 972 F.2d 1260 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The purpose of placing the prima facie burden on the Patent Office is to protect the applicants from use of hindsight based upon applicant's own disclosure. As such, only the facts gleaned from the prior art may be used and the knowledge of the applicant's disclosure must be put aside. M.P.E.P. § 2142.

The system of independent Claim 35 is patentable for at least the same reasons as Claim 32.

Because the cited references do not teach or suggest all of the elements of the claimed invention as recited in independent claims 32 and 35, and because there is no objective suggestion or motivation in either of the references to combine those references, Applicants respectfully request that the rejection be reconsidered and that independent claims 32 and 35 be passed to allowance.

Additionally, because claims 33-34 and 36-38, depend from the independent claims and recite further limitations thereon, Applicants also request that the Examiner pass those claims to allowance.

CONCLUSION

In view of the foregoing, Applicant respectfully submits that the pending claims are in condition for allowance and requests favorable action. The Examiner is welcome to contact Applicant's attorney at the number below with any questions.

Respectfully submitted,

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